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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,783	11/12/2003	Harleigh C. Mason	393-66965-01	7792

7590 01/24/2005

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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/712,783	MASON ET AL.	
	Examiner	Art Unit	
	Susan B. McCormick-Ewoldt	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 November 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

The amendment of November 8, 2004 is hereby acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of Application

The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1654.

Claim Rejections- 35 U.S.C. § 112

The rejection of claim 1 under 35 U.S.C. 112, first and second paragraphs, is withdrawn in view of Applicant's amendment.

Claim Rejection 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 remains rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right application number, 20001727, (European Community) in view of Applicant's admission that 'Rosy Glow' was sold as early as July, 2000 (page 4, paper number 6, of reply filed June 16, 2003).

Response to Arguments

Applicant argues that the combination of the Plant Breeder's Right Application 20001727 and foreign sales of 'Rosy Glow' did not enable the 'Rosy Glow' trees under *In re Elsner*. This is not persuasive though the argument is true it is not relevant to the issue at hand. The issue at hand is whether a foreign disclosure, published over one year prior to filing, with insufficient detail to enable the invention on its own, but enabling the invention when combined with knowledge of one of ordinary skill in the art, where such a person could have obtained the necessary plant stock for propagation from outside the U.S. over one year prior to filing, is insufficient to bar patentability under 35 USC § 102(b). As taught in MPEP 2131.01, when the claimed subject matter is disclosed identically by the reference, an additional reference may be relied on to show that the primary reference has an

"enabled disclosure." *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985) (Compound claims were rejected under 35 U.S.C. 102(b) over a publication in view of two patents. The publication disclosed the claimed compound structure while the patents taught methods of making compounds of that general class. The Applicant argued that there was no motivation to combine the references because no utility was previously known for the compound and that the 35 USC § 102(b) rejection over multiple references was improper. The court held that the publication taught all the elements of the claim and thus motivation to combine was not required. The patents were only submitted as evidence of what was in the public's possession before Applicant's invention.). Therefore, a foreign disclosure describing the claimed subject matter, published over a year prior to the filing of the domestic application, is an enabling bar under 35 USC § 102(b) where the plant stock necessary for propagation could have been obtained over a year prior to domestic filing, countering Applicant's argument.

Applicant argues the 'Rosy Glow' trees that were sold to the few orchardists were under an agreement not to propagate or distribute the trees. Therefore, the sales did not enable those skilled in the art to reproduce 'Rosy Glow' without undue experimentation, because those in possession of the trees were not permitted to propagate or distribute the trees. This is not persuasive because those skilled in the art could have read the PBR contacted the Applicant and purchased the plant. In addition, the Applicant did actually sell the claimed plant more than a year prior to filing which constitutes an enabled disclosure.

For the reasons discussed above and in the previous action, the rejection is deemed proper and is maintained.

Summary

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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